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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,705	03/17/2000	Robert A. Luciano	732.083	3145
21707	7590	03/25/2004	EXAMINER	
IAN F. BURNS & ASSOCIATES 1575 DELUCCHI LANE, SUITE 222 RENO, NV 89502			MARKS, CHRISTINA M	
			ART UNIT	PAPER NUMBER
			3713	16
DATE MAILED: 03/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/527,705	LUCIANO, ROBERT A.
	Examiner C. Marks	Art Unit 3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 January 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4, 9, 10, 12-14, 19-40, 45-50, 52, 54, 56, 65, 66, 70, 74, 76, 77 and 80-84 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-4, 9, 10, 12-14, 19-40, 45-50, 52, 54, 56, 65, 66, 70, 74, 76, 77 and 80-84 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>15</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 1, 9, 37 and 65 are objected to under 37 C.F.R. §1.75(i) which states:

- (i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

These claims present a number of elements and steps under each letter without such indentation; therefore, such formatting needs to be applied in response to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 82 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is indefinite in that a skilled artisan would not understand what is meant by the first apparatus is mounted adjacent to the first apparatus.

For this reason, the claim will be examined as best understood by one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 9, 10, 12-14, 19-36, 50, 52, 54, 56, 65, 66, 70, 80-81, 82 (as best understood), and 83-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over

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Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Crawford et al. (US Patent No. 6,270,412).

Mayeroff et al. disclose a gaming apparatus to play games of chance wherein the apparatus consists of a first housing portion housing a spinning reel first game of chance (FIG 2, reference 110) with an outcome display, an award display (FIG 1, reference 40), a first game actuator (FIG 2, reference 138) that is activated for play by the game player. Furthermore, the apparatus consists of a second housing portion housing a spinning wheel second game (FIG 2, reference 150) with a range of outcomes that can alter the award to the game player (Abstract) by providing an additional award. The second game is mounted atop the first and is proximate and adjacent in an integral game frame with the first game of chance whereby the player can observe both games from one location (FIG 1) and the second game has an outcome display and an actuator (FIG 2, reference 140) that is activated by the primary gaming unit has randomly selected one of a plurality of indicia sets (Column 5, lines 23-26). All spins of the rotating wheel bonus game are winning spins (Abstract, lines 14-15) therefore the wheel outcome includes an award to the game player. Mayeroff doesn't disclose such awards are continuing plays into the base game.

Stanley teaches of an amusement apparatus that has a first type of game that upon a predetermined completion will initialize a second type of game and success on the second game will lead to a further game on the first game (Abstract). In the disclosed apparatus, the second game can lead to an alteration of the result of the first game of chance (page 5, lines 21-23) by obtaining a predetermined alteration outcome as a result of the game, such as rotating the reels (FIG 4, reference 10, NUDGES, SPIN A WIN) and changing the first game outcome in the first game outcome display and providing a chance-improving outcome as the reels can then be moved to a winning combination. The second game is of the type that there are a number of

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holes in which the playing piece can fall down. Though for explanation purposes, Stanley defines the game as a "game of skill", a skilled artisan also understands the enormous chance element also present. Stanley even precludes the assumption of a game of skill by admitting the player can only to a small degree influence the outcome. Stanley states that the player can to a small degree influence the run of the ball. However, a skilled artisan would understand that if the player can only influence the ball to a small degree, there must be a large degree of chance involved as to where the ball will fall. There is also the chance that the tilt switch will activate as well. The small degree to which the outcome is influence would not, within the definitions of the art, entirely and wholly define the game as a pure game of skill. There is just as much, if not more, luck and chance involved in the outcome. Thus, the game as defined by Stanley is still indicative of features of a chance game and thus would not preclude a skilled artisan from understanding its relevance and teaching relating to a game of chance. The results would still cause the re-spins, etc. from which the rejection is based. Stanley allows for the first game to be altered by replaying it, awarding a prize, or other such features as roulette play or nudges. Stanley does not explicitly disclose a symbol being awarded but a skilled artisan would find such inclusions obvious as it would complement the primary game as do the other disclosed symbols of Stanley. The inclusion of certain symbols and or events over others would be a design choice obvious to a skilled artisan who would be motivated by the desired design/effect of the system.

Further another alteration of the first game outcome provided for by the second game would be to spin until a win is achieved (FIG 4, reference 10, SPIN A WIN). The second game is connected to the first game and is activated upon predetermined completion of the first game (Abstract). Stanley discloses that upon success in the second game, the first game of chance can again be replayed (Abstract). Stanley also discloses an additional award can be won from

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the second game based upon a predetermined outcome (FIG 4, reference 10, win L3) thereby increasing the total award provided to the player. Though Stanley does not distinctly disclose that upon the first game of chance being played again, the second game is again activated, this is strongly implied to one or ordinary skill in the art by Stanley in that the bonus game allows the play of the first game to again occur (Abstract, "successful completion of the fruit machine game initiating play on the pinball game and successful completion of the pinball games leading to a further game on the fruit machine") and thus it would be understood by one of ordinary skill in the art that the same paytable is again used as was in the original game. Therefore, if the "nudges" or "spin until a win" are obtained from the bonus game in order to replay the first game, if a result in the replay of the first game resulted in a predetermined completion associated with the bonus game, the bonus game would obviously be re-enacted. Further, the logic used that causes the first game to initiate the bonus game would obviously still be present upon a re-entrance of the first game as caused by the second game. One of ordinary skill in the art would understand that upon re-entering the first game, the same rules would be used to determine winnings, including possible situation to enact the bonus again. One of ordinary skill in the art would further be motivated to apply the same rules used previously in the base game, as it would be even more complex to change them. For example, if a "7 7 7" caused a bonus game to occur, and in the bonus game the player achieved a "spin a win" award and again upon playing the base game received a "7 7 7" representing a win, one of ordinary skill in the art would understand and surely find it reasonable to Stanley and suggested that a bonus game would then be reenacted based on the disclosure of Stanley and that which is known in the art.

Crawford teaches of a slot machine with a symbol save feature which allows a player to save in memory (and retrieve for later use in determining a winning combination) one or more symbols from one or more previous games and use those symbols in a current or future game

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to obtain a winning combination (Abstract, lines 3-5) and alter the likelihood of obtaining an award. The symbol save feature can be saved from a game of chance and transferred to another game of chance output display (Abstract, lines 6-8). This device is located on the gaming machine (FIG 5, reference 54).

Applicant notes that an ongoing motivation of the gaming industry is to develop slot type machines that are more exciting to play and thus more likely to be played and generate revenue. Stanley teaches of an amusement device where play is more exciting given the fact that the bonus round can alter the base round and there are such bonus awards as spin until a win and nudge. With these additional features, the bonus game would become much more exciting to the user as there is higher anticipation of a positive result from the bonus. By incorporating an apparatus that provides the user with a higher anticipation of an award and greater excitement, the lure of the machine is greatly increased and the goal of the gaming industry is met as the slot machine is more exciting to play and thus more likely to be played and generate revenues.

A skilled artisan would recognize the bonus possibilities associated with the Stanley game. The player could be lured with the possibility of earning future play on the base game while at the same time still be getting bonus awards. This would motivate a skilled artisan to incorporate a means to do so, as disclosed by Stanley. The Mayeroff patent does not allow for interactive gaming as Stanley does. Free spins are known in the art as a means to award players. There are a number of bonus games cited in relevant art below award just that, continued play on a base game. It is known that any means of continued play and perception of greater chance of winning is a distinguishing factor in drawing players to a machine. No casino is going to buy a boring machine that does not have the potential of drawing a large number of users. Casinos go for the exciting games that offer the player multiple winning ways and

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opportunities. Boring and as simple as the motivation may be, it is very strong among designers. The desire to make the next best thing.

Some players like bonus games, some players like free games, some players like interactive gaming. By combing the references a skilled artisan would recognize the ability to create an exciting game that would draw all types of players and provide casinos with greater revenue, which in turn would draw casinos to the artisan's work, which means more profit. These are always considerations of a designer in searching for a new product. The need for exciting high profit game motivates all designers. The reasons stated above for why Stanley would provide excitement to Mayeroff are easily recognizable to a skilled artisan and the motivations for using them would also be apparent as every designer is motivated to create the best, most exciting, and most popular machines and to do so they know their motivations and decisions must be made with player interest in mind.

As disclosed by the motivations above, it would have been obvious to one skilled in the art at the time of invention to incorporate the bonus round teachings of Stanley into the apparatus of Mayeroff to create a game of chance where the bonus round is more exciting and enticing to the user. Further, as is well known in the art, when a user perceives a greater chance of winning on a gaming machine, the user is more likely to participate in play of that machine. By incorporating the symbol save feature of Crawford into the apparatus of Mayeroff in view of Stanley, the user would get even more enjoyment out of the bonus round as it would be possible to save a bonus features for use at a later time. The designer would also be on the same motivation though process that is highly detailed above. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate the teachings of Crawford into the apparatus of Mayeroff in view of Stanley to create a bank in which the user could store a symbol obtained in the bonus round for use in the primary round at a later time in order to give

the user a feeling of better control over their own fate in the game, thus giving a perception of a greater likelihood of award winnings.

Regarding the method steps of claims 65, 66, and 70, Mayeroff teaches a method of a base game of chance used to procure a first base game outcome and upon the appearance of a predetermined outcome, a bonus opportunity is given (Abstract). Mayeroff also then teaches of actuating the bonus game of chance to procure a bonus game outcome and upon the appearance of a predetermined outcome, an award is given. Stanley teaches a method of once the bonus game is initialized, awarding the player to again play the base game of chance upon a certain combination (Abstract). Crawford teaches a method of using a bank portion for a bonus game to transfer the symbol to a base game of chance. Based upon the obviousness to combine these references and the motivation stated above, it would have been obvious to one of ordinary skill in the art to incorporate the method disclosures garnished from the teachings into the device as disclosed above.

Mayeroff discloses a spinning wheel game and Stanley discloses a spinning reel game. The incorporation of the actual type of slot machine used would be obvious designing to a skilled artisan as all types are known and widely used. The actual decision to use one over another would be a design choice motivated by the needs and desires for the designers particular system.

Claims 37-40, 45-49, 74, 76, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Crawford et al. (US Patent No. 6,270,412) further in view of Kaku.

What Mayeroff, Stanley, and Crawford disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Kaku et al. teaches of increasing user enjoyment by increasing the number of combinations that would produce a winning result (page 3, lines 11-14). To address this issue, the disclosed invention includes three donut-shaped disks that are in a concentric relation (page 4, lines 1-2) and have patterns of numbers, letters, or pictures (page 4, line 25). The disks are rotated independently and are stopped separately (page 5, line 1-2), thus they spin sequentially. Moreover, the number of disks can be made two (page 8, line 15).

By replacing the wheel device of the bonus round with the concentric wheel device taught by Kaku et al., the user would enjoy the bonus round more as the number of winning combinations would appear to be or actually be increased. This would provide more excitement to the user than a solo rotating wheel as there would be more than one rotating factor involved in determining the result of the bonus round. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate a different design choice as a means for presenting the bonus round. By incorporating the design choice taught by Kaku et al., the user would experience a greater sense of enjoyment from the bonus round as it would be more exciting when a plurality of spinning wheels are involved and a greater sense of a winning possibility is experienced.

Response to Arguments

Applicant's arguments filed 28 January 2003 have been fully considered but they are not persuasive.

In response to the Applicant's discussion of Mr. Loren Nelson, though the Applicant contends with the opinion of the Office regarding the Affidavit, the Applicant did not acknowledge any such factual support exists. Further, the Office is not seeking impossible facts regarding the gaming machine structure. There remains no documentary support provided for Mr. Nelson's conclusions.

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Regarding Applicant's argument that Stanley doesn't teach a game of chance, the Examiner respectfully disagrees. The second game is of the type that there are a number of holes in which the playing piece can fall down. Though for explanation purposes, Stanley defines the game as a "game of skill", a skilled artisan also understands the enormous chance element also present. Stanley even precludes the assumption of a game of skill by admitting the player can only to a small degree influence the outcome. Stanley states that the player can to a small degree influence the run of the ball. However, a skilled artisan would understand that if the player can only influence the ball to a small degree, there must be a large degree of chance involved as to where the ball will fall. There is also the chance that the tilt switch will activate as well. The small degree to which the outcome is influence would not, within the definitions of the art, entirely and wholly define the game as a pure game of skill. There is just as much, if not more, luck and chance involved in the outcome. Thus, the game as defined by Stanley is still indicative of features of a chance game and thus would not preclude a skilled artisan from understanding its relevance and teaching relating to a game of chance. The results would still cause the re-spins, etc. from which the rejection is based.

Regarding the Applicant's argument that Stanley does not allow the player to replay the first game of chance, the Examiner respectfully disagrees as detailed above. Further applicant's statement about a normal additional game is not conducive to the claim language, which does not support such narrow interpretation.

Regarding Applicant's argument that the Office's interpretation of spin to a win was incorrect, the Examiner respectfully disagrees and submits a skilled artisan knows that such phrasing in relation to slot machines means that the machine will spin until the player receives a winning outcome. This concept is prevalent throughout the art. This is still playing the game. The game is the slot itself, and the spinning would represent playing, as the outcome will still be

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analyzed with the same table. Further, skilled artisans know that spin a win is still a random outcome as the machine spins only until a win. It does not just spin directly to a non-random winning combination preset in memory. Thus, the applicant's argument stating that because the result is nonrandom, the first game is not replayed is not persuasive.

With respect to the Applicant's argument that Stanley does not inherently teach or even imply the particular payable and re-enacting of the bonus game as asserted, the Examiner respectfully disagrees. As disclosed above, the features are implied by Stanley. To address this situation, the Examiner has expounded this position above in the rejection and will repeat it here for clarity. Though Stanley does not distinctly disclose that upon the first game of chance being played again, the second game is again activated, this is strongly implied by Stanley in that the bonus game allows the play of the first game to again occur (Abstract, "successful completion of the fruit machine game initiating play on the pinball game and successful completion of the pinball games leading to a further game on the fruit machine") and thus it would be understood by one of ordinary skill in the art that the same payable is again used as was in the first game. Therefore, if the "nudges" or "spin until a win" are obtained from the bonus game in order to replay the first game result in a the predetermined completion associated with the bonus game, the bonus game would obviously be re-enacted. Further, the logic used that causes the first game to initiate the bonus game would obviously still be present upon a re-entrance of the first game as caused by the second game. One of ordinary skill in the art would understand that upon re-entering the first game, the same rules would be used to determine winnings, including possible situation to enact the bonus again. One of ordinary skill in the art would further be motivated to apply the same rules used previously in the base game, as it would be even more complex to change them. For example, if a "7 7 7" caused a bonus game to occur, and in the bonus game the player achieved a "spin a win" award and again upon

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playing the base game received a "7 7 7" representing a win, one of ordinary skill in the art would understand and surely find it reasonable to Stanley and suggested that a bonus game would then be reenacted based on the disclosure of Stanley and that which is known in the art. The Examiner believes that one of ordinary skill in the art would find the implications from Stanley to re-enact the base game for the reasons stated above.

In response to the Applicant's arguments that the generalized motivation in the industry to provide more exciting games is not a motivation to select the asserted features and combine the three references, the Examiner respectfully disagrees. The features selected are based upon more exciting games. In the Stanley reference, this is the capability to re-enter the bonus game after the base game and in the Crawford reference, this is the ability to save certain symbols for use at a later time. These features provide requisite motivation to select and choose them, as they are both known in the art to further attract users and make the game more exciting with possibilities.

In response to the Applicant's arguments that there is no motivation or suggestion to select, pick, and choose features from four references, the Examiner respectfully disagrees. The combination of Kaku et al. was used in order to provide support for an alternate embodiment of the invention wherein instead of three drums spinning independently, a concentric wheel game is used in said. Such a substitution is notoriously well known in the art as disclosed by the Examiner and would be an obvious design choice to an ordinary artisan as an obvious alternative to using three drums not only because such a substitution is notoriously well known, but also because as disclosed by Kaku et al. that it is a more enjoyable presentation method to users. The Examiner asserts that this combination of select features from four references does not constitute impermissible hindsight for the reasons disclosed above. The Examiner asserts there is adequate motivation as would be present to one of

ordinary skill in the art and the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Different motivations exist to those of ordinary skill in the art and though they differ from one artisan to another, these motivations are still suggested by the record. Further, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See MPEP 2145 X. In the instant case, it is well known in the art that creating bonus games that present the user with the sense that they have a better chance of winning is a goal of the gaming industry. The teachings of Stanley disclose that a bonus game that is enacted by a base game can provide a further game on the base game to improve the chances of winning. The teachings of Crawford disclose that a symbol can be saved from a base game and then applied to a later or bonus game to improve the chances of winning. All of these teachings are drawn towards improving the chance of winning in a bonus game for a user. These teachings constitute a motivation in that they provide an improved chance in a bonus game enacted by a base game, such as the disclosed of Mayeroff. One of ordinary skill in the art would be motivated henceforth to combine these teachings in order to provide features that will give the user a better sense of a winning possibility. Further motivation resides in the fact, that upon combination, users would be more enticed to play a game that they perceive having a better chance of earning winnings, thus creating a more prolonged play and increased revenue for the casino. Such a motivation is well known in the art

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and therefore creating combinations to reach the goal of increasing user enjoyment would be obvious to one of ordinary skill in the art.

The Examiner respectfully disagrees with the Applicant's contention that the combinations were made in hindsight and error. Motivation for each piece was supplied as well as to why the combination would be obvious. These have been highlighted both in the rejections as well as this argument section.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,513,846: Discloses a bonus game that can have the effect of awarding free spins, thus causing a further game on the primary game.

US Patent No. 5,342,049: Gaming machine where result on a second game can cause the reels of the first game to spin.

US Patent No. 6,648,757: Bonus game wherein there are a number of types of awards that can be given to the player, including further credits to be used in the primary game.

US Patent No. 6,312,334: Segmented gaming where bonus values can be converted into free plays for the primary game.

US Publication 2003/0199309: Gaming machine with bonus wherein if a certain combination occurs the player is awarded subsequent plays on the primary game.

US Patent No. 6,572,471: Gaming machine with bonus round that allows selection of elements that lead to allowing further play on the primary game.

US Patent No. 5,980,384: Gaming machine with primary and secondary games inexplicitly linked to where they are affecting each other throughout plays.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cmm
March 15, 2004


Teresa Walberg
Supervisory Patent Examiner
Group 3700